

REMARKS/ARGUMENTS

Claims 10-25, 35 and 36 remain in the application.

Claims 15, 17, 19, 21-24 and 36 are currently amended.

Claim Rejections Under 35 U.S.C. § 112

Claims 15-17, 19, 23-24 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 and claim 17 are amended to remove any inconsistencies with base claim 36 and to more particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 is amended to allow further description of the invention without including other components in addition to those recited. Claim 23 is amended to cure the lack of antecedent basis. Claim 24 is cured of indefiniteness by the amendment of claim 23.

Claim Rejections Under 35 U.S.C. § 102

Claims 13, 14, 21, 22, 35 and 36 were rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent 3,425,421 to Feder. The applicant disagrees that Feder discloses a single "resilient elastic retainer (spring steel wire)" as the examiner contends in the Office Action.

Rather, as taught by Feder, the holding wire 15 is made of "spring steel." Column 3, lines 32-40. Feder's teaching of "spring steel" clearly distinguishes the holding wire 15 from the "resilient elastic retainer," as recited in claims 35 and 36. Feder's use of the term "spring steel" does not characterize the holding wire 15 as having any "elastic" properties. The use of the term "spring steel" merely states the intended use of a formed steel as the term "spring steel" refers to any of a family of processed metals such as a hot or cold rolled carbon alloy steel, a pre-hardened and tempered carbon steel, a stainless steel or a nickel plated steel. Thus, the holding wire 15 of Feder is clearly not taught as an "elastic" retainer as recited in claims 35 and 36. This lack of teaching is exemplified by the preferred .094 inch diameter.

The inelastic character of the holding wire 15 is further exemplified by the teaching of a formed hook in one end of the holding wire 15. Column 3, lines 27-32. An "elastic" retainer could not be permanently formed as having a "hook" in one end as taught by Feder. Feder teaches the intent of the holding wire 15 is as a "directory holding wire" (see, column 1, line 60; column 1,

lines 70-column 2, line 2; and column 3, lines 23-40) capable of holding a phone directory "suspended at its center" (see, see, column 4, lines 5-7) as an integral part of an entire holding structure. See, column 4, lines 5-30. An "elastic" retainer employed in this position would not provide the structural capability intended by the invention. Accordingly, substitution of an "elastic" retainer, as recited in claims 35 and 36, would clearly render the device of Feder unsuitable for its intended purpose of holding a directory, particularly a telephone directory. See, e.g., "Background of the Invention" at column 1, lines 27-55; and "Summary of the Invention" at column 1, line 57-column 2, line 2.

Thus, at least because the "spring steel wire" taught by Feder fails to anticipate the "resilient elastic retainer" recited in claims 35 and 36, claims 35 and 36 are believed to be allowable.

Claims 13 and 14 are allowable at least as depending from allowable claim 35.

Claims 21 and 22 are allowable at least as depending from allowable claim 36.

Claim Rejections Under 35 U.S.C. § 103

Claims 19-21, 25, 35 and 36 were rejected under 35 U.S.C § 103(a) as being unpatentable over US Patent 6,045,159 to Bellah in view of US Patent 2,808,908 to Lykes. The applicant disagrees that Bellah teaches a "rigid elongated support bar" and a "single resilient elastic retainer" as recited in claim 19.

Bellah teaches a book holder **10** that comprises, as major components, a backing **12**, a spring assembly **14** and a fabric cover **16**. See, e.g., column 2, lines 50-54. The combination of the backing **12**, spring assembly **14** and a cover **16** of Bellah is not a rigid support "bar" as recited in claim 19.

As defined by Miriam-Webster's Collegiate Dictionary, Tenth Edition, a "bar" is: "1a: a straight piece (as of wood or metal) that is longer than it is wide and has any of various uses (as for a lever, support, barrier or fastening) b: a solid piece or block of material that is usually considerably longer than it is wide <a ~ of gold, a candy ~>."

Instead, the backing **12** comprises a stiff sheet **22**, such as cardboard or the like, which is creased along parallel lines **24** to provide a central spine **26** and a pair of panels **28**. The creases **24** allow the panels **28** to pivot along parallel axes between open and closed positions where the

panels **28** overlie one another. Column 2, lines 55-60. The spring assembly **14** is necessary to support the stiff sheet **22** and bias the holder to an open position (column 2, lines 16-19, see also, column 2, line 61-column 3, line 32). Holding the book in an open position is the object of the Bellah invention. See, column 1 lines 3-5. Obviously, because the backing **12** is formed with a creased stiff sheet **22**, the book holder **10** would tend toward a closed position by design. The stiff sheet **22** will not provide the “rigid elongated support bar” recited in claims 19, 20, 35 and 36 at least because the stiff sheet **22** requires the spring assembly **14** for stiffness.

Further, Bellah fails to disclose a bar structure at all. According to the Merriam-Webster dictionary, a bar is defined as “**1a:** a straight piece (as of wood or metal) that is longer than it is wide and has any of various uses (as for a lever, support, barrier, or fastening); **b:** a solid piece or block of material that is usually considerably longer than it is wide; **c:** a usually rigid piece (as of wood or metal) longer than it is wide that is used as a handle or support.” The backing **12**, spring assembly **14** and a cover **16** taught by Bellah clearly do not embody a bar structure. A “bar” cannot a combination of parts that must be *tied together* in order to provide any sort of rigidity as is the description of the backing **12**, spring assembly **14** and cover **16** taught by Bellah.

In contrast, the present invention as recited in claims 19, 20, 35 and 36, provides a “rigid elongated support bar” as an actual “bar” consistent with the dictionary definition.

Thus, at least because Bellah fails to disclose or suggest any “rigid elongated support bar,” claims 19, 20, 35 and 36 are all believed to be allowable, and reconsideration and allowance is respectfully requested.

Furthermore, the examiner argues that Bellah teaches the “function” of a rigid support bar as requiring the combination of three parts: the cardboard backing **12** with the creases **24** in the stiff sheet **22**, the spring assembly **14** and the cover **16**. In contrast, the present invention as recited in claims 19, 20, 35 and 36, provides a “rigid elongated support bar” as an *actual bar* according to the dictionary definition without the necessary *combination* with a spring assembly nor a fabric cover, as required by Bellah. Thus, the present invention as recited in claims 19, 20, 35 and 36 provides the “function” of the combination of parts taught by Bellah, but without the added components of a spring assembly **14**, cover **16** or backing **12** required by Bellah. Therefore, the present invention eliminates the added parts of Bellah while retaining the function, which is a clear indication of non-obviousness.

For at least these additional reasons, claims 19, 20, 35 and 36 are all believed to be allowable, and reconsideration and allowance is respectfully requested.

Additionally, claim 19 and claim 36 both teach “anchors” provided adjacent to both respective first and second opposite ends of the elastic retainer. Bellah fails to disclose first and second anchors structured to secure the first and second ends of the retainer to spaced apart edges of the support bar. Rather, Bellah only teaches a strap **18** that is permanently attached at one end **50** to the cover **16** by placing it under stitching **44**. Column 3, lines 63-65.

The strap **18** is disclosed by Bellah as one of the major components of the book holder **10** and is, when applied, used to hold the pages of the book open and flat against the cover **16**. However, the strap **18** of Bellah is formed of a transparent flexible plastic. Therefore Bellah teaches away from the combination with Lykes because the elastic cord **5** of Lykes is not transparent. Bellah requires a transparent strap to allow the user to read the print visible through the strap. Column 1, lines 58-67. In particular, Bellah teaches: “The transparent strap has several functions. In the open position of the book holder, the strap holds the book pages flat against the holder while allowing the user to *read the print visible through the strap.*” Column 1, lines 64-67 (emphasis added).

In contrast to the “transparent” strap **18** of Bellah, Lykes teaches a “pair of heavy elastic cords or springs” **5** for holding the copy or reading material in place. Column 2, lines 23-29.

Bellah cannot be combined with Lykes because substitution of the heavy elastic cords or springs **5** of Lykes for the “transparent” strap **18** of Bellah would clearly render the book holder **10** of Bellah unsuitable for its intended use of reading the print therethrough. Thus, Bellah teaches away from any combination with Lykes.

For at least the reasons stated above, claims 19, 20, 35 and 36 are believed to be allowable over the cited art. Claim 25 is also allowable at least as depending from allowable claim 19.

Claims 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over 6,045,159 to Bellah in view of 2,808,908 to Lykes and further in view of 6,453,589 to Schwartz.

Claims 15-17 are allowable at least as depending from allowable base claim 36.

Furthermore, claims 15-17 are allowable independently of allowable base claim 36.

As the examiner admits, and the applicant agrees, Schwartz teaches an “elastic string” **ST1** that is a “fabric elastic coated elastic” although it can be a “pure rubber band.” Column 4, lines 41-43. However, for the same reasons that Lykes cannot be combined with Bellah, so too Schwartz cannot be combined with Bellah.

Schwartz can not be combined with Bellah because Bellah requires strap **18** to be “transparent” to allow the user to read the print visible through the strap. Column 1, lines 64-67, reprinted herein above. Bellah clearly teaches away from the combination with Schwartz because the “elastic string” **ST1** of Schwartz is not “transparent.” Thus, Bellah cannot be combined with Schwartz because substitution of the “elastic string” **ST1** of Schwartz for the “transparent” strap **18** of Bellah would clearly render the book holder **10** of Bellah unsuitable for its intended use of reading the print therethrough. Thus, Bellah teaches away from any combination with Schwartz.

For at least the reasons stated above, claims 15-17 are believed to be allowable.

Claims 10, 11, 12, 14, 21-24 and 35 were rejected under 35 U.S.C § 103(a) as being unpatentable over US Patent 2,808,908 to Lykes in view of US Patent 5,722,691 to Patel.

Claims 10, 11, 12 and 14 are allowable at least as depending from allowable claim 36.

Claims 21-24 are allowable at least as depending from allowable claim 35.

Regarding claim 35, the Office Action only states, “See rejection in office action mailed 7-28-2005.” However, claim 35 was added after the office action mailed 7-28-2005 and in response thereto. Therefore, the comments recited in that office action cannot be applied by the applicant to claim 35.

However, the applicant believes claim 35 is allowable over Lykes in view of Patel.

Claim differs in scope from allowable claim 19. However, the above arguments directed to claim 19 are sufficiently applicable to claim 35 as to make repetition unnecessary. Thus, for each of the reasons above, claim 35 is believed to be allowable over the cited art.

The invention of claim 35 is clearly patentable over Lykes and Patel, both individually and in combination.

The holding device of Lykes requires (**item 1**) a large back board (main back member 1) and (**item 2**) a protruding lip or shelf rest 2 upon which a book 63 is placed. Column 1, lines 61-63. The holding device of Lykes further requires (**items 3 and 4**) two elastic cords 5 fitted across the back board 1 from top to bottom between two slots 3 in the top edge of the back board 1 and two slots 4 in

the shelf rest 2 along the bottom edge of the board 1. Column 2, lines 22-41 and Figures 1 and 5. These two elastic cords 5 each cross the pages on only one side of the book, and further cross the page from top to bottom of the book.

Lykes also requires a secondary retaining element formed of a bar 7 (**item 5**) and a spring or elastic band 8 (**item 6**) with the bar 7 mounted across the width of the back board 1 and over the pages of the book 63 for holding the pages of the book 63 against the back board 1 so the pages lie flat or are protected from a breeze or draught that could disturb them. “The bar is placed over the front of the book, and the elastic or spring behind the main back 1.” Column 2, lines 42-59 (quoting column 2, lines 50-51).

Thus, Lykes requires no less than six different components to accomplish the function provided by the present invention. Lykes requires: **item 1**: a large back board; **item 2**: a protruding lip or shelf rest 2; **items 3 and 4**: two elastic cords 5, one for each side of the book; **item 5**: secondary retaining bar 7; and **item 6**: spring or elastic band 8 for retaining bar 7.

In contrast, the present invention recited in claim 35 requires only two parts: the support bar, and a single resilient elastic retainer.

Note that the omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896,149 USPQ 556 (CCPA 1966) as recited in MPEP § 2144.04 (II)(B).

Thus, **by law**, the present invention is non-obvious over Lykes as omitting one or more elements and retaining its function.

The present invention omits, for example, the two elastic cords 5 (**items 3 and 4**) that are required by Lykes to run lengthwise of the book with one being provided for each side of the book, one for holding pages against the book’s front cover, and one for holding pages against the book’s back cover. Yet, the single elastic retainer of the present invention provides this function by running across the book and holding the pages against both the front and back covers at once.

For at least this reason, the invention of claim 10 is patentable over Lykes.

The present invention also omits, for example, the secondary retaining element formed of a bar 7 (**item 5**) and the spring or elastic band 8 (**item 6**) that retains it. Yet, the single elastic retainer of the present invention also provides this function while providing the function of the two elastic cords 5 (**items 3 and 4**) and the bar 7 (**item 5**) and the spring or elastic band 8 (**item 6**). Thus, the

present invention provides the functions of four elements: items 3, 4, 5 and 6, in a single elastic retainer element.

For at least this additional reason, the invention of claim 10 is further patentable over Lykes.

Furthermore, the Examiner admits, and the Applicant agrees, that Lykes fails to disclose or suggest the support bar being substantially flat, nor the support bar comprising compacting means.

Patel cannot be combined with Lykes because no combination of Patel and Lykes results in the support bar and a single resilient elastic retainer of the present invention. Lykes, as discussed above, already requires too many elements to accomplish the function of the present invention. Combination with Patel cannot reduce the number of elements required by Lykes to provide the function of the present invention.

For at least this reason, the present invention is patentable over the combination of Lykes with Patel.

Furthermore, Lykes cannot be combined with Patel, except in a manner that is against the teachings of both Lykes and Patel, and render both unsatisfactory for its intended purpose.

According to the Office Action mailed July 28, 2005, the Examiner relies on the bar 7 and spring or elastic band 8 of the secondary retaining element of Lykes in combination with the rectangular member 20 of Patel and the means for folding it for rejecting claim 10 to the present invention. However, the bar 7 of Lykes must lie over the pages of the book, with the spring or elastic band 8 stretching around under the book covers. In contrast, the rectangular member 20 of Patel must lie under the covers of opened book 12, with pages 14a and 14b being held in place by adjustable holding clips 40 and 60. Column 3, lines 50-53, as follows:

FIG. 1 shows the page holder device 10 in a fully opened position and in an operational mode which has a book 12 opened with pages 14a and 14b being held in place by adjustable holding clips 40 and 60. Column 3, lines 50-53.

Any combination of Patel with Lykes requires reversing the positions of the elements. Either the bar 7 of Lykes must be moved to under the book covers with the spring or elastic band 8 stretching over the pages so the bar 7 cannot hold down the pages, which is its intended purpose; or the rectangular member 20 of Patel must be moved to over the pages with the holding clips 40 and 60

under the book covers so rectangular member 20 cannot position the clips 40 and 60 for holding the pages, which is its intended purpose.

Therefore, Lykes and Patel cannot be combined because such combination would render both unsatisfactory for its intended purpose.

Additionally, there is not any suggestion or motivation to combine Lykes and Patel, as required by law. The Examiner is reminded that a statement that modifications of the prior art to meet the claimed invention would have been " `well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references) as recited in MPEP § 2143.01.

Furthermore, because any combination of Lykes and Patel would render both unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) as recited in MPEP § 2143.01.

The only support member taught by Lykes is the large back board (main back member 1). The Examiner has argued that the bar 7 of Lykes substitutes for the support member of the present invention. However, the teaching of Lykes still does not support this argument. Rather, as taught by Lykes, the bar 7 is only effective to hold the pages against a breeze or draught that could disturb them. Column 2, lines 42-46. "The bar is placed over the front of the book, and the elastic or spring behind the main back 1." Column 2, lines 42-59 (quoting column 2, lines 50-51). Thus, Lykes provides absolutely no teaching that bar 7 is sufficient for supporting the book without the main back member 1. Accordingly, the main back member 1 must be the book support member.

The main back member 1 of Lykes must be wide to accommodate the protruding lip or shelf rest 2 upon which a book 63 is placed. Column 1, lines 61-63. Thus, attempting to combine the narrow rectangular member 20 of Patel with the main back member 1 of Lykes will necessarily render the main back member 1 of Lykes unsatisfactory for its intended purpose. For at least this further reason, Patel cannot be combined with Lykes.

Even if Lykes could be combined with Patel, which it cannot, Patel fails to provide the deficiencies of Lykes. Even if the hinge of Patel was combined with the main back member 1 of Lykes, the main back member 1 of Lykes still does not include means for compacting. Rather, the protruding lip or shelf rest 2 upon which a book 63 is placed would render impossible compacting the main back member 1. Additionally, the supporting plate 16, friction hinge 17, and bolt and nut assembly 18 on the back of the main back member 1 for attaching it to leg 11 and base 13 upon which it stands prevents any compacting of main back member 1. Therefore, hinge 30 of Patel cannot provide the means for compacting the support bar, as required by claim 19.

Furthermore, there is absolutely no teaching or suggestion that providing means for compacting the main back member 1 of Lykes would not render the holding device of Lykes unsatisfactory for its intended purpose. Rather, it is clear that providing means for compacting the main back member 1 of Lykes renders the holding device of Lykes unsatisfactory for its intended purpose.

Therefore, for at least the above reasons, Patel cannot provide the deficiencies of Lykes.

For at least the above reasons, claim 35 is believed to be allowable and allowance is respectfully requested.

Claims 18 and 36 were rejected under 35 U.S.C § 103(a) as being unpatentable over US Patent 2,808,908 to Lykes in view of US Patent 5,722,691 to Patel and further in view of US Patent 4,462,614 to Krause.

Regarding claim 36, the Office Action only states, “See rejection in office action mailed 7-28-2005.” However, claim 36 was added after the office action mailed 7-28-2005 and in response thereto. Therefore, the comments recited in that office action cannot be applied by the applicant to claim 36.

However, the applicant believes claim 36 is allowable over Lykes in view of Patel and Krause.

Claim 36 differs in scope from allowable claims 19 and 35. However, the above arguments directed to claims 19 and 35 are sufficiently applicable to claim 36 as to make repetition unnecessary. Thus, for each of the reasons above, claim 35 is believed to be allowable over the cited art.

The invention of claim 35 is clearly patentable over Lykes and Patel, both individually and in combination. Furthermore, Krause fails to provide any of the deficiencies of Lykes and Patel. Krause fails to provide any of: a rigid elongated support bar; a means for compacting the support bar; a resilient elastic retainer; and first and second anchors provided adjacent to respective first and second opposite ends the resilient elastic retainer, as recited in claim 36. Therefore, Krause cannot provide any of the deficiencies of Lykes and Patel.

For at least the above reasons, claim 36 is allowable.

Claim 18 is allowable at least as depending from allowable claim 36.

Claims 15-17 were rejected under 35 U.S.C § 103(a) as being unpatentable over US Patent 2,808,908 to Lykes in view of US Patent 5,722,691 to Patel and further in view of US Patent 6,453,589 to Schwartz.

Claims 15-17 are all allowable at least as depending from allowable base claim 36.

As discussed above, the invention of claim 19 is clearly patentable over Lykes and Patel. Schwartz only teaches a **file folder**. See, e.g., Abstract. Therefore, Schwartz cannot provide the deficiencies of Lykes and Patel.

Regarding claim 17, the Office Action only states, “See rejection in office action mailed 7-28-2005.” However, in office action mailed 7-28-2005 claim 17 was rejected only as depending from intervening claim 15. The office action mailed 7-28-2005 did not address the merits of claim 17. Therefore, the comments recited in that office action cannot be applied by the applicant to claim 17.

Claim 17 is further allowable independently of base claim 19 at least as reciting a plurality of the anchoring means formed at one of the first and second opposite ends of the elastic retainer, and further as being spaced at intervals along the elastic retainer.

Nothing in the cited references discloses or suggests providing a plurality of the anchoring means formed at one of the first and second opposite ends of the elastic retainer, as originally recited in claim 17. Therefore, claim 17 is believed to be allowable as originally presented.

The present amendment to claim 17 is only to correct a minor informality and is not believed to be necessary for patentability of the claim.

Serial No. 10/ 743,164
Amdt. dated March 13, 2006
Reply to Office action of November 16, 2005

Examiner's Response to Arguments

The examiner on page 6 of the present Office Action stated that, because the applicant has added claims 35 and 36 using "consisting essentially of" language, these claims were construed as being equivalent to "comprising." The examiner therefore rejected claims 35 and 36 with new art and copied some of the rejections relied upon in the previous rejection mailed 7-28-2005.

However, as noted herein, claims 35 and 36 were not present when the rejection was mailed 7-28-2005. Therefore, the applicant cannot know how these rejections are applied to the new claims 35 and 36.

Furthermore, claims 19 and 20 still use the "consisting of" language. But the examiner has treated these claims as if they used the "consisting essentially of" language recited instead in claims 35 and 36. Therefore, the examiner has improperly examined these claims as being equivalent to "comprising."

The applicant believes that claims 19 and 20 would be found allowable if the examiner applied the proper "consisting of" standard of examination. Therefore, reconsideration and allowance is respectfully requested.

The claims now being in form for allowance, reconsideration and allowance is respectfully requested.

If the Examiner has questions or wishes to discuss any aspect of the case, the Examiner is encouraged to contact the undersigned at the telephone number given below.

Respectfully submitted,

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